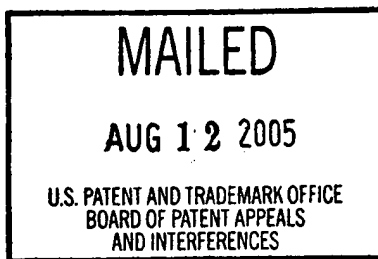


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE AUGUST FUSZ



Appeal No. 2005-1491
Application No. 09/426,954

ON BRIEF

Before THOMAS, RUGGIERO, and GROSS, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1, 3-17, 19-26 and 28.

Representative claim 1 is reproduced below:

1. A method for prompting an individual to create an anonymous data profile for the individual, said method comprising the steps of:

providing the individual with access to a database;

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requesting anonymous profile information, about the individual be entered into the database;

maintaining the anonymity of the individual through an inability to accept contact information in the profile; and compensating the individual for either or both of entry of the anonymous profile information and feedback provided in response to marketing data.

The following references are relied on by the examiner:

Goldhaber et al. (Goldhaber)	5,855,008	Dec. 29, 1998
Kepecs	6,009,411	Dec. 28, 1999
		(filed Nov. 14, 1997)

Claims 1, 3-17, 19-26 and 28 through stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Goldhaber in view of Kepecs.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and reply brief for appellant's position and to the answer for the examiner's positions.

OPINION

For the reasons set forth by the examiner in the answer, we sustain the rejection of all claims on appeal under 35 U.S.C. § 103. We add the following to embellish upon the examiner's reasons and the teachings and suggestions in the applied prior art.

We observe first that no arguments are presented as to any dependent claim associated with any of the respective independent claims 1, 8, 16 and 22. It appears that only common arguments among these independent claims are made in the respective discussions of each of them in the principal brief on appeal. Indeed, the principal argument is directed to the feature of "maintaining the anonymity of the individual through an inability to accept contact information in the profile" as set forth generally in each independent claim on appeal. Additionally, independent claim 8 recites the feature of "administering to each individual a password, absent any contact information for the individual." Independent claim 16 requires "the first set of information lacking information relating to a name, an address, a telephone number, and a social security number of the individual." A corresponding feature is also recited in independent claim 22 on appeal where it is stated "each consumer generated data set including a set of individual characteristics, though refusing a name, an address, and social security number entry for the consumer." Thus, each independent claim on appeal has some form of recitation of a negative

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limitation with respect to the nature of the profile information associated with each individual user of a database.

Each of the separately stated rejections of the independent claims on appeal beginning at page 4 of the answer indicates that "Goldhaber et al does not disclose maintaining the anonymity of the individual through an inability to accept contact information in the profile." Although it may well be said that the artisan may view Goldhaber's teachings in this manner as asserted by the examiner, it appears to us that there are significant teachings, if not strong suggestions, of this feature alleged by the examiner not to be present in Goldhaber. We make general reference here to these locations in Goldhaber which support the examiner's view as well our present view as to the nature and scope of the teachings of this reference: column 6, lines 27-49; column 6, lines 66 through column 7, line 1; the showing in Figure 7 and the discussion at column 12, line 21 through column 14, line 62, particularly the example given there with emphasis on the teachings at column 12, lines 49-52, column 13, line 38-44 and 53-55 and column 14, lines 9-12 and 18-21. Note also the rollup teachings at column 20, lines 38-57.

What appears to be unappreciated by the examiner is that the statement at lines 31 and 32 of column 6 that the viewer profiles are to remain private includes the specific teachings at lines 43-44 that "profiles can be private (pseudonymous)." That is, they can be used and even marketed while protecting the consumer's true identity. For example, a merchant may be permitted such a scan profile to determine his affinity for the customer but cannot learn the customer's name or address. Contacts between advertisers and consumers can be brokered by a "profile bank" that protects the "consumer's privacy." It is thus apparent that Goldhaber teaches the capability of the user entering pseudonyms, that is, false names, to the extent that he otherwise teaches that contact information may be entered.

In connection with the latter capability, the confidentiality of each consumer is also guaranteed by the discussion associated with Figure 7 that the database there only "may" include contact information in the nature of information shown in this Figure. Beginning at line 41, it is also emphasized that at the registration time the consumer's computer only "may" display a questionnaire and associated information requesting the consumer to provide identity information such as that which is listed at columns 12 and 13.

It thus appears that the teachings and suggestibility of Goldhaber are inclusive of the inability of the system to accept contact information and a user profile to the extent broadly recited in each independent claim on appeal. This capability is in addition to the optional embodiments that include the ability of the consumer to enter such personal contact information, but the system denies its availability to specified advertisers and marketers which is clearly within the context of the subject matter broadly recited in the claims on appeal. More specifically, to the extent contact information is suggested to be sought by the profile system of Goldhaber, it is not made available to the advertisers and marketers without the permission of the consumer himself or herself.

Thus, the inability of these intermediary agents in Goldhaber to send contact information to advertisers and marketers appears to us to say in other words that advertisers and marketers are not able to accept it in their profiles since they are unable to retrieve it. These intermediaries are also discussed in terms of the trading house arrangements in the latter Figures and discussions of Goldhaber such as to permit the anonymity of the consumer to the use of various agents in

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anonymous transactions such as those discussed at column 20, lines 38-57.

On the other hand, to the extent the artisan would interpret Goldhaber's teachings and suggestions as not disclosing the ability of maintaining the anonymity of an individual to an inability to accept contact information in a profile, Kepecs clearly teaches this as argued by the examiner. We note the following teachings for emphasis: the abstract's discussion at lines 3 and 4 that "an account which is associated with a unique key is maintained for each consumer account." Thus, the use of the particular key taught throughout Kepecs is with respect to an account not necessarily an individual. The initial privacy concerns at the bottom of column 1 and the background discussion of Kepecs sets the basis for the privacy discussions beginning with the initial lines at column 2 at lines 1-6, lines 33-35 and for emphasis lines 49-54 which are relied upon by the examiner. This latter portion states "[i]n one embodiment of the present invention, no direct consumer identification is maintained in the consumer account to preserve the anonymity of the consumer." (Column 2, lines 49-51.)

Additionally the nature of the present invention is emphasized in this particular respect by the discussion at column 3, lines 47-55. The discussion at column 5, lines 54-60 as relied upon by the examiner plainly indicates that "a unique key identifies the account of each consumer but not necessarily the actual identity of the consumer." In addition to the user being able to select his or her own key, the discussion beginning at column 6, line 4 includes the significant teaching relied upon by the examiner at lines 51-59 that the lowest level of identification of the key is the use of the key with no other identification data. There, it is also stated that "the consumer is completely anonymous." The examiner's reliance upon the teaching at column 7, lines 53 and 59 is also buttressing to the examiner's position as is the summary at column 12, lines 43-50.

Furthermore, we observe that appellant's showing of Figure 3 of the method of generating anonymous data profiles of an individual as disclosed and that the corresponding discussion at pages 4-6 of the specification as filed are consistent with the teaching of Goldhaber of using passwords such as discussed at column 13 beginning at line 21 as well as the lowest level of the usage of the key in Kepecs.

The examiner's statement of combinability of the applied prior art is set forth initially as to representative independent claim 1 on appeal in the discussion at the top of page 5 of the answer which we reproduce here:

Both Goldhaber and Kepecs are concerned with an effective method of marketing products to potential consumers, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include maintaining the anonymity of the individual through an inability to accept contact information in the profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

Correspondingly, we agree with the examiner's reasoning set forth as to combinability of the applied prior art at pages 11-13 of the answer:

With respect to argument 3, Appellant asserts that Kepecs does not teach an inability to accept contact information. The Examiner respectfully disagrees, and submits that Kepecs discloses a lowest level of identification being a unique key (i.e., account identification) with no other consumer identification data (column 6, lines 52-59). This particular embodiment, as disclosed by Kepecs, includes no other contact identification or information, and indeed discloses Appellant's limitation of maintaining the anonymity through an inability to accept contact information in the profile. Identifying the consumer by the key **only**, includes both an inability to store and an inability to accept contact information. Any additional inclusion or acceptance of information would

not be included in the **lowest level of identification**, but in other levels of identification, as disclosed by Kepecs. In addition, Appellant argues that the consumers do not appear to be anonymous with respect to the retailers or financial institutions. This assertion is incorrect. By using the lowest level of identification, the consumer is actually not identifiable by the discount administration process (DAP) system, the retailers, or financial institutions. Appellant's citations to various portions of Kepecs, refer to other Levels of identification, not the lowest level of identification. Further, Kepecs discloses that the knowledge of the key does not compromise the security of the system, since the consumer's identity is unavailable for harassment (column 7, lines 54-56).

Appellant goes on to argue that the key in the DAP system is networked to other computer systems, at least some of which may associate the key with consumer identifying accounts. The Examiner respectfully disagrees with Appellant's interpretation of Kepecs. Merely being networked to other computers does not destroy the anonymity of the lowest level of identification. Actually, being anonymous to DAP, via the lowest level of identification, allows the consumer to remain anonymous when accessing their account (column 6, lines 45-47) and knowledge of the key does not compromise the security of the system, since the consumer's identity is unavailable for harassment (column 7, lines 54-56).

With respect to argument 4, Appellant argues that there is no suggestion to combine the references. The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both

Goldhaber et al and Kepecs are concerned with an effective method of marketing products to potential consumers, via consumers profiles. In addition, Kepecs discloses an exchange of benefits between the consumer and discounter, in return for information regarding the consumer's interests (column 4, lines 10-14). This is similar to Appellant's claim language of compensating an individual for entry of profile information and/or feedback, as seen in claims 1, 8, 16, and 22. More importantly, this exchange of benefits for information regarding the consumer profile, provides motivation to be combined with the consumer interest profile 124, as seen in Goldhaber et al, which is also exchanged for benefits (i.e., compensation to the consumer). However, since the consumer profile 124 in Goldhaber et al does not have an inability to accept contact information, Kepecs is used in combination, thereby resulting in an anonymous identification of the consumer, whereby the consumer's identity is unavailable for harassment, as disclosed by Kepecs (column 7, Lines 53-57).

Appellant's remarks in the reply brief appear not to come to grips with these positions of the examiner and make only a few general references to the responsive arguments portions of the answer. It is thus, plainly, not well received as appellant asserts that the Office has not identified any motivation suggesting the advantages for combinability of the applied prior art as set forth at page 2 of the reply brief. Likewise, the examiner has not exercised any "20-20 hindsight" as set forth at page 3 of the reply brief since the examiner has clearly relied upon prior art teachings that are available in the prior

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art. The examiner's rationale does not appear to us to have relied upon appellant's disclosed invention.

We do not agree with appellant's views that Kepecs does not relate to a system for generating an anonymous state of profiles as urged at page 12 of the principal brief on appeal. Even though we may agree with appellant's statement at the bottom of page 4 of the reply brief that Kepecs never states that the DAP computer is unable to accept contact information, we do so only to the extent that Kepecs never positively states this. It is plain to us and we believe to the artisan that Kepecs' system is in certain embodiments unable to accept contact information to the extent recited in the claims on appeal.

The examiner's analysis that we quoted earlier in this opinion is not consistent with the broad urging that the examiner has exercised prohibited obvious to try rationale in the combinability of Goldhaber and Kepecs as set forth at pages 11 and 12 of the principal brief on appeal. We simply do not see that the evidence provided by the examiner and the rationale of combinability is consistent with a prohibited obvious to try rationale. In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673,

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1681 (1988) indicates that an obvious to try rationale is permitted within 35 U.S.C. § 103 as long as the prior art provides a reasonable expectation of success, while not providing only general guidance or the varying of all parameters or trying each of a significant number of possible choices until one arrived at the claimed invention. Obviousness does not require absolute predictability of success.

In view of the foregoing, the decision of the examiner rejecting all claims on appeal under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Anita Pellman Gross
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Administrative Patent Judge

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